

### REMARKS/ARGUMENTS

Claims 22-24, 29 and 57-58 are active.

Claim 22 is amended to be an independent claim, by incorporating the formula from Claim 1. Multiple dependencies and "preferred" limitations have been removed.

Claims 57 and 58 are substantial copies of claim 29 differing by the claim to which they depend.

No new matter is added.

The rejection under 35 USC 112, second ¶ to claims 1-3 is no longer applicable as those claims have been cancelled and in Claim 22 the optional substituents are indentified. Withdrawal of the rejection is requested.

It is respectfully submitted that the enablement applied under 35 USC 112, first ¶ is no longer applicable as the scope of the claims is commensurate with the compounds provided and tested in the examples.

The rejection applied under 35 U.S.C. 103 (a) citing the WO 03/010159 description is not applicable to the claims presented here as the compound in the claims differ from those in WO03/010159 by at least two substituents.

Specific comparisons of the WO '159 compounds and the claims is as follows:

- While in compounds 15, 22-23, 27, 102-112, 117-119, 129 of WO03/010159, Y is  $-\text{CH}_2-$  or  $\text{CH}_3-\text{N}<$ , in the present invention the corresponding moiety is  $-\text{NH}-$
- While in compounds 15, 22-23, 27, 102-112, 117-119, 129 of WO03/010159, there is a methyl in the 4-position of the phenyl ring, in the present invention the 2-position (i.e. B) is a  $-\text{CH}_2-\text{OH}$  or a  $-(\text{C}=\text{O})-\text{O}-\text{CH}_3$  group.

Therefore, the disclosures in WO '159 cited in the rejection are not an adjacent homologs that allows one to make the substitution to achieve that which is claimed. (See "Where an invention for which a patent is sought is a compound which is a member of an homologous series and the prior art discloses a *nonadjacent* member of that series, we do not consider the Hass and Henze cases authority for the legal presumption of obviousness of the claimed invention." *In re Elpern*, 326 F.2d. 762, 140 USPQ 224 (CCPA 1964)).

These at least 2 differences have shown to provide special biological activities to the group of compounds claimed. It would not have been obvious to one of ordinary skill in the art at the time of the claimed invention to make these changes in the core structure and expect significant biological activities in the nanomolar range.

Withdrawal of the rejection is requested.

With respect to the provisional rejection citing 10/566,399, in accordance with MPEP § 822.01, If the "provisional" double patenting rejection in the present application is the only rejection remaining, the examiner should then withdraw that rejection and permit the present application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the present application issues as a patent.

It is respectfully submitted that all of the claims are in proper form for allowance.  
Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Respectfully Submitted,

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(OSMMN 08/07)

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